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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,174	12/20/1999	SHINICHI TSUJIMOTO	35.G2518	2015
5514	7590	10/27/2003		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER FLETCHER, JAMES A	
			ART UNIT	PAPER NUMBER
			2615	
			DATE MAILED: 10/27/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/467,174

Applicant(s)

TSUJIMOTO, SHINICHI

Examiner

James A. Fletcher

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-15, 17, 19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-15, 17, 19, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 10-15, 17, 19, and 21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10, 15, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claims 10, 15, 17, and 19**, the claims all discuss converting location information to location information. This language is confusing and unclear to the examiner. The examiner has assumed the converted location information to be a second information, and has examined the claims in that light.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10, 13-15, 17, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al (6,507,371).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

**Regarding claims 10, 17, 19, and 21,** Hashimoto et al disclose a device comprising:

- an input device for inputting, from an image recording medium into which a picture-taking image is recorded, location information associated with the picture-taking image as original information (Col 2, lines 55-63 "a memory system such as a hard disk drive [HDD] or magnetooptical disk [MO]...and a bus connecting the above units");
- a conversion device for converting the original information inputted by the input device to a second information in a predetermined representation form (The second embodiment, beginning on Col 4, line 30, discloses a means and method of using the existing location information to look up a more descriptive location information via the Internet. Also note Fig. 15.); and
- a recording device for recording the location information in the predetermined representation form converted by the conversion device into the image

recording medium (See Fig 5B, item 310, which indicates the storage of this information. Also see Col 5, lines 37-39, which is a text description of this figure.).

**Regarding claim 13**, Hashimoto et al disclose an apparatus further comprising a selection device for selecting a representation form in which the recording device records into the image recording medium (Col 4, lines 46-48 "it is possible to gradually expand a range...in accordance with a conversion table").

**Regarding claim 14**, Hashimoto et al disclose an apparatus wherein the input device inputs latitude and longitude information as the original information (Col 4, lines 36-37 "This embodiment basically shows the pieces of information for latitude and longitude").

**Regarding claim 15**, Hashimoto et al disclose an apparatus wherein the conversion device converts the location information to at least one representation form of a character form, a code form, and a latitude and longitude form (Col 5, lines 50-51 "Position information is change to the above city name or the like").

***Claim Rejections - 35 USC § 103***

**6.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al as applied to claim 10 above, and further in view of Nealton (5,023,635).

**Regarding claim 11**, although Hashimoto et al suggest an apparatus that further comprises a selection device for selecting whether the location information in the predetermined representation form converted by the conversion device is recorded into the image recording medium along with the original information or not (Col 7, line 18 "There is a method of inputting no data"), they do not specifically disclose storing determined data along with original data.

Nealton teaches optionally storing new data along with existing data (Col 7, lines 51-55 "the order entry station plays back the new or modified instructions it now stores, which are transmitted to the photofinishing system for recording"). As suggested by Hashimoto et al and taught by Nealton, being able to store the original data along with the new data permits the original data to be retrieved without degradation or distortion. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a means for determining whether original and derived data would be stored together or not.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al as applied to claim 10 above, and further in view of Funazaki.

**Regarding claim 12**, although Hashimoto et al suggest an apparatus wherein the input device inputs the original information that is magnetic recorded on a film (Col 3, line 65- Col 4, line 3 "Image and location information can be recorded in an analog

recording medium such as a silver film or a digital recording medium such as a flash memory”), they do not specifically disclose the use of a magnetic recording on a film medium.

Funazaki teaches the storage of auxiliary photographic data on a magnetic area of a photographic film (Col 4, lines 20-24 “the processor controls a procedure for recording the shooting conditions selected and the data read out of the ROM in the magnetic recording area of the film via the magnetic head”). As suggested by Hashimoto et al and taught by Funazaki, storing of auxiliary photography data such as location data on a magnetic track on a film permits a high quality image storage with additional data in a format where the image and the data are preserved together. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to record location data on a magnetic portion of a film.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (703) 305-3464. The examiner can normally be reached on 7:45AM - 5:45PM M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew Christensen can be reached at (703) 308-9644.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231

**or faxed to:**

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**(703) 872-9314 (for Technology Center 2600 only).**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JAF  
September 30, 2003

  
VINCENT BOCCIO  
PRIMARY EXAMINER